

# BEST AVAILABLE COPY

Serial No. 10/798,123

Docket No.34916CIP

## Remarks:

Newly presented claims 24-26 remain for consideration in this application. Original claims 1-23 have been canceled without prejudice and subject to presentation in continuing application(s). In view of the newly submitted methods claims, the rejections of the first action are respectfully traversed.

The present invention is directed to a method which solves a long standing problem confronted by those who string electrical lights. As explained in the specification, it often happens that such light strings are "reverse-wrapped" at a mounting location such as a doorway or eave. Specifically, if the user begins wrapping the string beginning with the male connection end and moving toward the intended electrical outlet, the string after wrapping ends up with the female connection end of the string in relatively close proximity to the intended electrical outlet, while the opposed male end is remote from the intended outlet. When this occurs, there has heretofore been no way of effecting the electrical connection, because a conventional electrical extension cord does no good. If the male end of the conventional extension cord is plugged into the female end of the light string, there is no way to connect the remaining female end of the extension cord with the wall outlet. Use of yet another conventional extension cord presents the very same issue. Accordingly, it has been heretofore necessary to take down the light string and rewrap it at the desired location in order to effect the necessary electrical connection.

The present method overcomes this problem by providing a way of accommodating the reversed-wrapped light string and permitting electrical connection thereof without the need for detachment and rewrapping. This novel method is fully set forth in independent claim 24.

Specifically, it will be seen that the claim is drawn to a method of wrapping and electrically connecting a light string (e.g., Christmas lights) so as to provide electrical power from an outlet; the light string including an electrical cord presenting opposed male and female ends, with a plurality of lights along the length of the cord.

The method includes the steps of first selecting a location for the light string from a defined group of sites, and then wrapping the string of lights at the location. In this step, reverse wrapping occurs, i.e., the light string is mounted by beginning the wrapping from the male end thereof and moving towards the electrical outlet, which means that the female connection end is left in relatively close proximity to the electrical outlet and the opposed end is remote from the outlet. Next, the string of wrapped lights is coupled to the electrical outlet *without* the necessity of removing the light string and rewrapping it. This involves providing an electrical connection assembly having male electrical plugs at both ends, taking this assembly and moving one end thereof to a location adjacent the female connection end of the light string, inserting the one male electrical plug into the adjacent female connection, taking the other male connection plug of the assembly to a point adjacent the outlet and inserting the other male connection plug into the outlet. The for mentioned steps of taking and inserting the male connection ends into the female connector end and outlet being carried out while the string remains in its reverse wrapped orientation.

Dependant claims 25 and 26 recite that the connection assembly is made up of a first convention an extension cord and a second extension cord having male connection plugs at both ends thereof; and where the male electrical plugs are each two-prong plugs.

In the first action, the Applicant presented claims drawn to the combination of a light string and an electrical connector assembly (claims 17-19) and to a method of connecting a light string (claims 20-23). The claims were rejected on the basis of Epps in view of Wu. The latter reference merely disclosed a string of lights having male and female connection ends, whereas Epps describes a disabling jack for use with an appliance such as a stereo. In Epps, the user, concerned with unauthorized use of the appliance, severs the male electrical plug of the device and installs in lieu thereof a female connector. Next, the user provides a double-male electrical cord which is inserted into the newly installed female connector on the appliance cord, and into an electrical socket. Thereafter, when the user desires to prevent the use of the appliance, the double-male connector is simply removed, thereby making it impossible to electrically power the appliance.

The Epps reference, alone or with combination with Wu, does not teach or suggest the presently claimed method, and any effort to apply this art to the present claims would involve impermissible hindsight reconstruction of the art.

First of all, it is clear that the art must suggest the desirability of the claimed invention, i.e., there must be a motivation to combine the references. Such motivation can be derived from the nature of the problem to be solved, the teachings of the art, and the knowledge of those of ordinary skill. Without such a motivation, there is no *prima facie* obviousness. See, MPEP §2143.01. Also, attention is directed to the attached case of *In re Dembiczak*, 50 USPQ 2d 1614 (Fed. Cir. 1999). In this case, the claimed invention was a large leaf bag having on one face thereof a jack-o-lantern design. Thus, when the bag was filled with leaves or other debris, the fanciful jack-o-lantern face was exhibited. The Patent Office rejected the claims on the basis of prior art disclosing large bags

and stylized jack-o-lanterns. The Federal Circuit reversed, remarking that a proper §103 analysis guarded against a forbidden hindsight reconstruction of the art. The CAFC went on to explain that a showing of motivation must be “clear and particular” and that broad conclusory statements are insufficient. Indeed, the Federal Circuit cautioned that particular findings regarding the suggestion, teaching or motivation to combine is especially important so as to make clear the position adopted by the PTO, to identify factual disputes, and to facilitate review. In sum, more than simple conclusory statements about a motivation to combine is required—there must be *evidence*.

Finally, the law is clear that merely because a claimed invention may be within the capabilities of one of skill in the art, this does not establish a *prima facie* case of obviousness. As clearly set forth in §2143.01 of the MPEP:

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combining the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Applying these principles, it is clear that there is no motivation to combine the Epps and Wu references. Epps deals with an appliance such as a stereo, and is directed to a method of apparatus for selectively disabling the appliance. This is the antithesis of the presently claimed method which is to wrap and electrically connect a light string. Stated otherwise, one seeking to solve the problem

of reverse-wrapped light strings would not be led to Epps which has nothing whatsoever to do with light strings and indeed is concerned with disabling an appliance. The intended purpose of Epps has nothing whatsoever to do with the presently claimed method ("if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984)). For these reasons alone, there can be no proper combination of Wu and Epps.


Applicants have made a sincere effort to present method claims which are in no way taught or suggested by the art. One need only review the specific method steps of claim 24 to confirm that the claimed method is completely beyond any applicable teachings of the art. Nowhere do Wu or Epps suggest selection of a light string location, reverse-wrapping of the light string at the location, and then electrical connection of the light string by using the claimed electrical connection assembly and the specific connection steps recited.

Applicant and her attorneys would like to thank the Examiner for her time and courtesies at the recent personnel interview. At that time, the Wu and Epps references were discussed, and the Applicant asserted that the art failed to include any suggestion or motivation to combine such that there was no *prima facie* case of obviousness. Although there was no agreement reached during the interview, the Examiner did indicate that presentation of method claims would perhaps receive more favorable consideration, as compared with combination claim 17. In light thereof, the present new method claims have been drafted and are presented herewith.

In view of the foregoing, a Notice of Allowance appears to be in order and such favorable action is solicited.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 19-0522.

Respectfully submitted,

By 

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